| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/716,781 | 11/18/2003 | Granville R. Fairchild | AOL0157 | 6168 |

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| 22862 | 7590 | 04/27/2006 | EXAMINER |

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

| EXAMINER |
|---|
| SYED, FARHAN M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2165 | |

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| | 10/716,781 | FAIRCHILD ET AL. |
| **Office Action Summary** | Examiner | Art Unit |
| | Farhan M. Syed | 2165 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _18 November 2003_.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-13_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-13_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _18 November 2003_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _09/01/2004_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.      Claims 1-13 are pending.


### *Drawings*

2.      The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: Figure 1, item 114.  Corrected drawing sheets in compliance with 37 CFR

1.121(d) are required in reply to the Office action to avoid abandonment of the

application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being

amended. Each drawing sheet submitted after the filing date of an application must be

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.

3.      The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference character(s) not mentioned in the

description: Figure 5, step 502a.  Corrected drawing sheets in compliance with 37 CFR

1.121(d), or amendment to the specification to add the reference character(s) in the

description in compliance with 37 CFR 1.121(b) are required in reply to the Office action

to avoid abandonment of the application. Any amended replacement drawing sheet

should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. Each drawing sheet submitted after the filing

date of an application must be labeled in the top margin as either "Replacement Sheet"

or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.


### Claim Rejections - 35 USC § 112

4.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.


5.      Claims 1, 7, and 13 are rejected under 35 U.S.C. 112, second paragraph, as

being incomplete for omitting essential steps, such omission amounting to a gap

between the steps.  See MPEP § 2172.01.  The initials steps in these claims discuss

providing, monitoring, communicating, and updating an aggregated catalog with respect

to the member's local storage and online data centers. That is, it is establishing a

relationship between such devices. However, the subsequent step of responsive to

each request by a member, searching the aggregated catalog and utilizing results of the

search to provide an output for display at the requesting member's computer, provides a

gap between the two steps. The Examiner will assume that the Applicant assumed that

a member submits a query request to the aggregated catalog, to which a response is

issued, where searching the aggregated catalog is performed.

6.      Regarding claim 13, the word "means" is preceded by the word(s) "aggregated

catalog" (line 6), "aggregator" (line 10), and "finder" (line 19) in an attempt to use a

"means" clause to recite a claim element as a means for performing a specified

function. However, since no function is specified by the word(s) preceding "means," it is

impossible to determine the equivalents of the element, as required by 35 U.S.C. 112,

sixth paragraph.  See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).


### *Claim Rejections - 35 USC § 101*

7.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

8.      Claims 1, 7, and 13 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

As per claims 1, 7, and 13, the claims clearly recite a "communicating with the

member computers to identify prescribed types of data objects newly stored in the

member computer's local storage". Applicant uses the word functionality on page 11 of

the specification, when describing a carrier wave, which would probably infer the

'functionality of the claims.' Thus, the Examiner understands that while communicating

with the member computers, a transmission of data occurs, where the prescribed types

of data objects are transmitted from the member computer's local storage to the on-line

data centers. According to page 11 of the Applicant's specification, storage is defined as

a signal-bearing media. Furthermore, on page 17 of the Applicant's specification, "...

signals may be represented using a variety of different technologies and techniques.

For example, any data, instructions, commands, information, signals, bits, symbols, and

chips referenced herein may be represented by voltages, currents, electromagnetic

waves, magnetic fields or particles, optical fields, or particles, other items, or a

combination of the foregoing." Based on these references, the Examiner understands

that implementing the claims mentioned above would render the result of the claims as

intangible. A signal-bearing medium is not tangible, and cannot tangibly embody a

computer program or process since a computer cannot understand/realize (i.e. execute)

the computer program or process when embodied on the data signal. Computer

program or processes are only realized within the computer when stored in a memory or

storage element (such as RAM or ROM). Therefore, a data signal does not meet the

"useful, concrete, and tangible" requirement as set forth in *State Street*, 149 F.3d at

1373, 47 USPQ2d at 1601-02, and hence claims 25-32 are non statutory under 35

U.S.C. 101.

### *Claim Rejections - 35 USC § 103*

9.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.    Claims 1, 3, 4, 6, 7, 9, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Hsiao et al (U.S. Patent No. 6,804,674 and known hereinafter

as Hsiao) in view of Johnson et al (U.S. Patent No. 6,878,384 and known hereinafter as

Johnson '384).


As per claims 1, 7, and 13, Hsiao teaches a method for operating an online

service facility selectively accessed by multiple member computers, the online service

facility including a plurality of online data centers operated by an online service provider

(OSP) to store members' data objects relating to a variety of online services that the

OSP renders to its members, the method comprising operations of (i.e. "*A scalable content*

*management system manages searches from a local content manager and a plurality of remote content*

*managers. A single scalable content manager manages data in a content repository or file system and its*

*associated metadata in the same content repository or in a database, which will greatly simplify both*

*content management logic and client application logic. The system architecture enables users to add*

*scalable content managers as needed, which allows users to easily scale up the scalable content*

*manager system, in both data size and user connection, as business grows. With the present scalable*

*system architecture, a multi-node content management system will appear to be a single content*

*management system to users, providing location transparency.*" The preceding text clearly indicates that

content management system contains members' data objects, which are content contained in the content

manager, which are stored in a plurality of on-line data centers. A plurality of content management

systems, as shown in Figure 6, item 650, clearly indicate that they are contained in a plurality of data

centers.)(Abstract; Figure 6, item 650): providing an aggregated catalog that contains

information including: (1) metadata identifying members' data objects residing in the

data centers, and (2) metadata identifying members' data objects residing in local

storage of respective member computers (i.e. *"The scalable content manager 515 manages the*

*metadata stored in a database 525 and the primary content stored in a local file system 530 or resource*

*manager, providing an integrated function of both metadata management and data (primary content)*

*management."* The preceding text clearly indicates that metadata are stored in the respective member

computer, which is a local file system and in the data center, which is a database. It is also understood by

an ordinary person skilled in the art that the content information can be stored in multiple databases,

again, which can reside in multiple data centers.)(Column 10, lines 49-53); communicating with the

member computers to identify prescribed types of data objects newly stored in the

member computers' local storage (i.e. *"If the query were to be satisfied by the remote content*

*managers 650, the communications manager 645 connects to other remote content managers 650 by*

*sending requests and receiving the search results, as described above in connection with the content*

*manager 515."* The preceding text clearly indicates that the communication manager allows

communication with other remote content managers, which are the member computers. The prescribed

types of data objects newly stored are contained in the query submitted by the user.)(Column 12, lines

12-16); updating the aggregated catalog to list the newly stored data objects from the

online data centers and member computers' local storage (i.e. *"When an object is inserted or*

*updated in a content management system, reference to and description of the object will also need to be*

*created or updated in order to provide data consistency and avoid a referential integrity (RI) problem." "In*

*addition, the scalable content management architecture provides an extensible architecture that enables*

*users to integrate new content, and to migrate existing content with ease and flexibility."* The preceding

text clearly indicates that an aggregated catalog is a type of content management system that can be

updated.)(Column 3, lines 21-25; column 4, lines 51-54); responsive to each request by a

member, searching the aggregated catalog and utilizing results of the search to provide

an output for display at the requesting member's computer, the output comprising a

consolidated listing of both online data objects and locally stored data objects owned by

the requesting member (i.e. *"Users, such as remote Internet users are represented by a variety of computers such as computers 37, 39, and can query a content management system 10 for the desired information." "It also provides a single system view to users of the content management system when metadata and objects are stored in multiple computer nodes. The location of an object and its associated"* The preceding text clearly indicates that a when a query is submitted by the user, a response is then returned to the user. In addition, included in a content management system contains an interface that allows a single system view to users of the content management system. Also, the single system view contains content that is pulled from multiple nodes, which include a locally stored data object owned by the requesting member and online data objects stored at the data center.)(Column 8, lines 32-35; column 4, lines 40-45).

Hsiao does not explicitly teach a method for monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members.

Johnson *'384* teaches a method for monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members (i.e. *"An information monitoring system for the collection of all real-time information activity between a user and a variety of information services. The real-time interaction between a user using a communication device to interface with an information service is monitored to collect certain predetermined information which characterizes the nature of the user's interaction with a particular information service."* The preceding text clearly indicates that monitoring content of the data center is a monitoring system.)(Abstract).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Hsiao with the teachings of Johnson *'384* to include a method for monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members with the motivation

to provide the functions needed for content creation, storage, search, management, and
distribution. (Hsiao, column 5, lines 13-15).


As per claims 3 and 9, these claims are rejected on the basis of independent
claims 1 and 7.


As per claims 4 and 10, Hsiao does not explicitly teach a method where the
operations further comprise: during display of the consolidated listing at the member's
computer, updating the display substantially in real time to reflect any data objects that
are of prescribed types, owned by the member, and newly stored in the online data
center during the display.

Johnson '384 teaches a method where the operations further comprise: during
display of the consolidated listing at the member's computer, updating the display
substantially in real time to reflect any data objects that are of prescribed types, owned
by the member, and newly stored in the online data center during the display (i.e. *"An
information monitoring system for the collection of all real-time information activity between a user and a
variety of information services. The real-time interaction between a user using a communication device to
interface with an information service is monitored to collect certain predetermined information which
characterizes the nature of the user's interaction with a particular information service."* The preceding text
clearly indicates that real time update is the real-time interaction between a user using a communication
device to interface with an information service.)(Abstract).

It would have been obvious to a person of ordinary skill in the art at the time of
Applicant's invention to modify the teachings of Hsiao with the teachings of Johnson

'384 to include a method where the operations further comprise: during display of the

consolidated listing at the member's computer, updating the display substantially in real

time to reflect any data objects that are of prescribed types, owned by the member, and

newly stored in the online data center during the display with the motivation to provide

the functions needed for content creation, storage, search, management, and

distribution. (Hsiao, column 5, lines 13-15).


      As per claims 6 and 12, these claims are rejected based on independent claims 1

and 7.


11.    Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hsiao et al (U.S. Patent No. 6,804,674 and known hereinafter as Hsiao) in view of

Johnson et al (U.S. Patent No. 6,878,384 and known hereinafter as Johnson '384) and

in further view of Kumamoto et al (U.S. Patent No. 5,805,858 and known hereinafter as

Kumamoto).


      As per claims 2 and 8, Hsaio and Johnson '384 do not explicitly teach a method

where: the consolidated listing includes a member-activatable VIEW feature; the

operations further comprise, responsive to activation of the VIEW feature in conjunction

with a particular one of the listed data objects, activating software to present contents of

the particular data object to the member.

      Kumamoto teaches a method where: the consolidated listing includes a member-

activatable VIEW feature; the operations further comprise, responsive to activation of

the VIEW feature in conjunction with a particular one of the listed data objects,

activating software to present contents of the particular data object to the member (i.e.

"When view feature data concerning each of the views is created, auxiliary knowledge data is selected on

the basis of the view feature data (step 202). One of a plurality of auxiliary knowledge data concerning the

front view is selected on the basis of view feature data concerning the front view. Further, one of a

plurality of auxiliary knowledge data concerning the top view and one of a plurality of auxiliary knowledge

data concerning the side view are respectively selected on the basis of view feature data concerning the

top view and view feature data concerning the side view.")(Column 31, lines 61-67; column 2, lines 1-4).

It would have been obvious to a person of ordinary skill in the art at the time of

Applicant's invention to modify the teachings of Hsiao with the teachings of Johnson

'384 and with the further teachings of Kumamoto to include a method where: the

consolidated listing includes a member-activatable VIEW feature; the operations further

comprise, responsive to activation of the VIEW feature in conjunction with a particular

one of the listed data objects, activating software to present contents of the particular

data object to the member with the motivation to provide the functions needed for

content creation, storage, search, management, and distribution. (Hsiao, column 5, lines 13-

15).

12.    Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hsiao et al (U.S. Patent No. 6,804,674 and known hereinafter as Hsiao) in view of

Johnson et al (U.S. Patent No. 6,878,384 and known hereinafter as Johnson '384) and

in further view of Johnson et al (U.S. Patent No. 5,964,839 and known hereinafter as

Johnson '839).

As per claims 5 and 11, Hsiao and Johnson '384 do not explicitly teach a method where the monitoring operation is carried out by at least one of the following operations: communicating with the data centers to identify data objects contained therein; monitoring members' activities conducted while accessing the online service facility.

Johnson '839 teaches a method where the monitoring operation is carried out by at least one of the following operations: communicating with the data centers to identify data objects contained therein (i.e. *"In addition, other substantive data (e.g., type of service, type and number of inquiries made, etc . . .) regarding the real-time interaction are collected. The information is collected in real-time, on a operation-by-operation basis, and is ultimately aggregated, for example, at the household level in a central location. The aggregated data is thereafter transmitted to a central server for data analysis purposes."*)(Column 3, lines 13-18); monitoring members' activities conducted while accessing the online service facility (i.e. *"An object of the present invention is thus to provide a system and method for the monitoring and collection of all inbound/outbound information activity and communications activity at a particular user location, for example, a household equipped with a variety of devices having communication capabilities. In accordance with an aspect of the present invention, the real-time interaction between a user and an external information service is monitored and specific data are collected regarding that real-time interaction. For example, when a user is connected to a commercial information service (e.g., CompuServe or Prodigy) connectivity data (e.g., date/time of interactive session, number of packets sent/received, file name, application ID, etc . . .) are collected."*)(Column 2, lines 66-67; column 3, lines 1-13).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Hsiao with the teachings of Johnson '384 and further with the teachings of Johnson '839 to include a method where the

monitoring operation is carried out by at least one of the following operations:

communicating with the data centers to identify data objects contained therein;

monitoring members' activities conducted while accessing the online service facility with

the motivation to provide the functions needed for content creation, storage, search,

management, and distribution. (Hsiao, column 5, lines 13-15).

### *Contact Information*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Farhan M. Syed whose telephone number is 571-272-

7191. The examiner can normally be reached on 8:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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FMS

JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100